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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,909	12/10/2003	M. Andre Bourquin	025200-043	6709
21839	7590	10/15/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			MCCORMICK EWOLDT, SUSAN BETH	
POST OFFICE BOX 1404			ART UNIT	
ALEXANDRIA, VA 22313-1404			PAPER NUMBER	

1654

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/730,909

**Applicant(s)**

BOURQUIN, M. ANDRE

**Examiner**

Susan B. McCormick-Ewoldt

**Art Unit**

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1654

### **DETAILED ACTION**

The amendment of July 29, 2004 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action dated May 10, 2004.

#### **35 USC § 102**

The rejection of claim 1 under 35 U.S.C. 112, first and second paragraphs, is withdrawn in view of Applicant's amendment.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right application number, 19951455, granted in the European Community in view of Applicant's admission that 'Boubri' was sold as early as September of 1990 (U.S. Plant Patent Application No. 10/125,421 (now abandoned) page 5, paper number 6, of reply filed May 6, 2003).

#### **Response to Arguments**

Applicant's remarks filed July 29, 2004 have been fully considered but are not considered persuasive for the following reasons:

**Applicant argues** the Examiner has cited no authority for assertion that the availability invention outside United States combined with a non-enabling publication has ever been a statutory bar other than the *Ex parte Thomson* decision. This argument has been fully considered, however, is not persuasive because the sale or public availability is the secondary evidence that the primary reference is an "enabled disclosure" (See MPEP 2131.01). *In re Samour* and *In re Donohue* both say that other evidence can be used to show that the publication was enabled. In *Donohue*, 226 USPQ 622 the Courts state, "The purpose of citing Lincoln and Wagner is, instead, to show that the claimed subject matter, as disclosed in Nomura, was in the public's possession. *Id.* Therefore, the anticipation rejection based on Nomura, Lincoln, and Wagner is proper." *In re LeGrice* states, "public use and sale of a plant are

Art Unit: 1654

the avenues by which a plant enters the public domain" (133 USPQ 371). Then *LeGrice* states, "The mere description of the plant is not necessarily an 'enabling' disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those skilled." In this case, the claimed plant was in the public domain since 1999 and the PBR publication is enabled because of the availability of the claimed plant, thus allowing one of ordinary skill in the art to make or use the instant plant.

**Applicant argues** that *In re LeGrice* continues to be the controlling authority. This argument has been fully considered, however, is not persuasive because in *LeGrice*, the Appellant never admitted the sale of the rose plants. The rose plants were not in possession of those skilled in the art. In contrast, in the present case, the Applicant admits that the claimed plant was in the public domain more than one year prior to the filing of this instant application. Therefore, one skilled in the art could have reproduced the claimed plant.

The assertion that it was apparent to those involved in the prosecution that the rose varieties involved in the *LeGrice* applications were available to the public in England, more than one year before the U.S. filing dates of the applications at issue is not clear from the written record. The issue of prior sale outside of the U.S. was not treated by the CCPA because the Appellant did not admit on record that the rose plants were available to the public.

Therefore, the rejection is deemed proper and maintained.

#### Summary

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

Art Unit: 1654

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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